

REMARKS:

In the Office Action the Examiner noted that claims 101-106 are pending in the application, and the Examiner rejected all claims. No new matter has been presented.

Thus, claims 101-106 are pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

REJECTIONS UNDER 35 USC §103:

In item 7 on page 5 of the Office Action the Examiner rejected claims 101-106 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,056,019 (Schultz) in view of U.S. Patent No. 5,201,010 (Deaton) in further view of U.S. Patent No. 4,882,675 (Nichtberger). The Applicants respectfully traverse the Examiner's rejections of the remaining claims.

In contrast to the claimed invention of providing cumulative points at the request of the customer, Schultz determines rewards based on the status report that is executed at a time prescribed by the central system (see, col. 7, lines 60-67). Meaning, Schultz is limited to providing a list of products for which rewards are available only on a periodic basis.

The Examiner acknowledges, at least on page 3, lines 7-9 in "Response to Argument" of the outstanding Office Action that Shultz fails to teach that **"the point balance is sent to the terminal after the customer identification and prior to performing a transaction by the customer"** (emphasis added). See also page 6 of the Office Action. Therefore, the Examiner has admitted that "a point sending unit" recited in current claims 101 and 102 and the feature of "sending the customer's current cumulative points" recited in current claims 103-106 is not disclosed in Shultz.

However, the Examiner has concluded, on page 4, lines 15-20 in "Response to Argument" and also on page 7, lines 9-12 in "Claim Rejections", that it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Schultz to include having the customer access their reward coupons as items are being purchased (before the purchase total) based on teachings of Deaton and Nichtberger. Applicants respectfully disagree for the following reasons.

In claims 101 and 102, it is recited that a point sending unit **"sends the customer's current cumulative points stored in the customer database to the terminal prior to performing transactions by the customer based upon the customer identification result"** (emphasis added). See also claims 103-106 reciting "sending" process.

With respect to Deaton, the Examiner pointed out that "Deaton teaches that the coupon reward and other incentives are made at the point of sale (POS) terminal" (see at least page 3 of the Office Action). This means that the coupon is displayed on the POS terminal after the commencement of and only in association with a transaction. Therefore, Deaton does not teach or suggest "prior to performing transactions", as taught by the claimed invention.

Deaton, explicitly states in col. 10, lines 31 – 44:

"... to initiate a check verification request, check reader 121 automatically scans the magnetic ink character recognition (MICR) data printed along the bottom edge of the customer's check and then the store clerk operates the keypad 122 to enter the amount of the check, along with the function code designating check verification. This request is displayed on display 124, and sent, along with data from the check reader 121, to transaction processor 112. The check verification response, including the customer's verification status (such as POSITIVE, NEGATIVE or CAUTION), and marketing information (such as the type of coupon to be dispensed) returned by the transaction processor is then displayed on display 124.

The above-identified operation is also reiterated in the explanation of the program flowchart (see col. 68, lines 13-67, particularly steps 5 - 13 of Deaton).

As can be seen from the above discussion, first, a customer hands his check to a store clerk, then the predetermined series of operations are carried out and only thereafter the coupon is displayed on the terminal. Thus, it is apparent that a transaction has already been started. Meaning, unlike the claimed invention of "prior performing transactions, Deaton is limited to only subsequent to commencement of a transaction.

The Examiner further points to col. 17, lines 30–61 of Nichtberger, on page 7, lines 4 - 8 of the outstanding Office Action. However, in Nichtberger, a customer inserts a special card into a local coupon distribution and redemption (CDR) unit 20 before the checkout process, the customer selects a coupon according to a request by this customer from the corresponding list displayed on the screen of the CDR unit 20, then the CDR unit 20 stores the selected coupon in a memory thereof. Thereafter, when a checkout process is to be achieved, a cash register terminal searches for goods corresponding to the above selected coupon from among the goods which the customer has purchased, where the cost for the goods is charged to the coupon supplier.

Therefore, Nichtberger does not disclose or suggest the claimed invention including, "the sending of the customer's current cumulative points stored in the customer database to the terminal prior to performing transactions by the customer based upon the customer identification

result", as taught by the claimed invention. Instead, in Nichtberger, a coupon is sent not to a cash register terminal, i.e. a terminal which executes a transaction, but to a CDR.

Moreover, Applicants respectfully submit that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. In this case, the Nichtberger system, which is directed to sending the coupon to a CDR which is separate and apart from the terminal, teaches away from sending reward information to the terminal for performing transactions as taught by the claimed invention. This is apparent since Nichtberger requires customers to stand in line before the cash register of the checkout counter (see column 17, line 30) to select the coupon, which is inconvenient for the customers, not practical, and decreases efficiency of a checkout processing. Therefore, in Nichtberger, the cash register terminal stands separate from the CDR.

It is respectfully submitted that none of the references teach or suggest the claimed "point sending unit" and "sending the customer's current cumulative points."

Further, even assuming arguendo that Schultz, Deaton, and Nichtberger did disclose the features discussed by the Examiner, the Applicants respectfully submit that there is no motivation to combine the cited references. The Examiner stated that the combination of the references would be obvious because it allows the customer to take advantage of earned coupons/rewards through their shopping history at the point of sale rather than having to make another trip back to the store or having to remember to bring the physical coupon reward.

However, absent hindsight, there is no reason for combining the cited references. For example, while Nichtberger may provide a reason for sending the coupon to a CDR using which a customer selects a coupon, Schultz and Deaton fail to suggest why a person of ordinary skill in the art at the time of the invention would be motivated to incorporate the coupon distribution and redemption such as discussed in Nichtberger. In other words, an attempt to bring in the isolated teaching of Nichtberger into the Schultz and/or Deaton system would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.

Therefore, withdrawal of the rejection is respectfully requested.

WITHDRAWAL OF FINALITY:

As discussed above, each of the independent claims are allowable over the cited references, and therefore, Applicants respectfully request reconsideration of the finality of the

rejection and withdrawal of the finality of the Office Action.

CONCLUSION:

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 11/21/2008

By: *Temnit Afework*
Temnit Afework
Registration No. 58,202

1201 New York Ave, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

CERTIFICATE UNDER 37 CFR 1.8(a)
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 11/21, 2008
By: *N. Johns*
STAAS & HALSEY
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